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UNITED STATES PATENT and TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper number 38

PJR

In re Application of Masaaki Yamanaka et al:

Serial No. 08/855,905 :
Filed: May 14, 1997 :
For: SYNTHETIC PAPER MADE OF
STRETCHED POLYPROPYLENE FILM

DECISION
ON
PETITION

This is a decision on the petition pursuant to 37 C.F.R. 1.181, filed May 5, 2003, requesting the withdrawal of the finality of the Office action dated January 27, 2003.

The petitioner provides the following arguments and evidence: 1.) The office action mailed to petitioner on January 28, 2002 was incomplete; 2.) The final office action dated January 27, 2003 was the first time that appellant was presented with a rejection of claims under 35 U.S.C 112, first paragraph; 3.) A statement that a thorough search of the office file of the petitioner had been made and no copy of the missing page from the office action of January 28, 2002 was found; and 4.) A copy of the office action dated January 28, 2002 as received by petitioner-from which page 2 is missing.

FACTS

The office action mailed on January 28, 2002 as found in the found in the official file at the patent office contains a page 2 on which is set forth a rejection under 35 U.S.C. 112, first paragraph. Petitioner responded to the office action of January 28, 2002 and did not respond to the rejection under 35 U.S.C. 112, first paragraph. Upon receipt of this response the examiner issued a final office action dated January 27, 2003. An interview between the Supervisory Patent Examiner of the unit in question and the petitioner resulted in a request by the supervisor for petitioner to respond to the outstanding rejection. Petitioner disagreed and has filed this petition for relief requesting a re-mailing of the office action and a restart of the statutory time period to respond.

DECISION

Upon receipt of petitioner's response to the January 28, 2002, the examiner did not hold the paper to be non-responsive but rather issued a final office action. The evidence presented by petitioner provides a convincing showing that the office action as received by petitioner was incomplete and as such the first opportunity petitioner had to respond to the rejection in question was in the final office action. Since the Office action of January 28, 2002, as received by petitioner, did not include a rejection under 35 U.S.C 112, first paragraph, no clear issue has been developed in the record and the finality of the January 27, 2003 Office Action was inappropriate.

The petition is **GRANTED**.

The application will be returned to the examiner for mailing of a new non-final office action with a restarted statutory time period.



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